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EXAMINER

PEACHES, RANDY

ART UNIT	PAPER NUMBER
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2617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/814,363

Applicant(s)

UNG ET AL.

Examiner

Randy Peaches

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. ***Claims 1-16, 20-25, 29-47, 51-56 and 60-62*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mcdowell et al (U.S. Publication 2001/0034224 A1) in view of Waesterlid (U.S. Patent Number 6,993,325 B1).

Regarding ***claims 1, 7, 32 and 38***, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039, 0047-0048 and applicant's admission on page 17, lines 26-28], a short message service (SMS) server and a service transfer point (STP) which reads on claimed "short message service center (SMSC)" and "service control point (SCP)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", a Message Event Server (MES), which reads on claimed "message handler," comprising:

- a registration notification message (REGNOT) and MSINACT, which reads on claimed "MSInactivity", receiver to alert other wireless users of a said user's presence (see paragraph [0032]). McDowell discloses in paragraph [0046], that REGNOT/MSINACT receiver is a Message Event Sever (MES) working in conjunction with the said HLR, capable of receiving and processing the user event information (e.g. network information relating to the presence and/or location of a said wireless user (see paragraph [0044, 0045]) received over a TCP/IP connection from a said HLR and further producing an associated presence and/or location. *The Examiner further maintains that the information is directly forwarded to the said SMSC via the HLR based on the architecture of FIGURE 1. The direct link between the HLR and the SMS is given so that the information received by the MES is sent to the SMS directly via the HLR;* and
- a registration notification message (REGNOT) and MSINACT, which reads on claimed "MSInactivity", forwarder to forward a said (REGNOT) and MSINACT received by a Message Event Server, over an internet connection to a device outside a wireless network. **NOTE:** (McDowell et al. teaches in paragraph [0040] and [0041] wherein the said SMS server sends an over the air message or similar type informing the said user of the presence of a subscriber. The instant function satisfies the limitation of "integrated in the SMSC", in that, the said SMS server forwards information to a user; therefore, a "forwarding mechanism" is a part of the architecture of the said SMS server). Also, as detailed in FIGURE 10a, the cellular network comprises the mobile switch center, which sends the

said registration notification message (REGNOT) and MSINACT to the said MES. Mcdowell et al. discloses in paragraph [0046] wherein the forwarded information details whether or not the information is sent to a user within the said wireless network or outside the said wireless network, which reads on claimed "device outside of a wireless network." See paragraph [0033, 0046].

However, Mcdowell et al. fails to clearly disclose wherein a wireless chat participant corresponding to said forwarded registration notification message being added to a chat room based on said forwarded registration notification message.

Waesterlid discloses in column 6 lines 49-67 and column 7 lines 1-62, wherein messages are communicated directly to other peers in a group. This peer-to-peer communication, as the Examiner has interpreted, is direct parallel to communication performed as users are associated to a chat room.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Mcdowell et al (U.S. Publication 2001/0034224 A1) to include Waesterlid (U.S. Patent Number 6,993,325 B1) in order to provide a communication system capable of utilizing peer-to-peer communication for registered members whereby a forwarded registration notification message is transmitted via the network to add said registered members to a respected communication groups (column 7 lines 2-19).

Regarding **claims 2, 8, 33 and 39**, as the combination of Mcdowell et al. and Waesterlid are made, the combination according to **claims 1, 7, 32 and 38**, Mcdowell et al (U.S.

Publication 2001/0034224 A1) discloses in paragraph [0039 and 0047-0048], a short message service (SMS) server and a service transfer point, which reads on claimed "short message service center (SMSC)" and "service control point (SCP)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", including said SMSC, a message handler wherein:

- Mcdowell et al teaches in paragraph [0035], that the said Internet connection utilizes a TCP/IP protocol.

Regarding **claims 3, 9, 34 and 40**, as the combination of Mcdowell et al. and Waesterlid are made, the combination according to **claims 1, 7, 32 and 38**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039 and 0047-0048], a short message service (SMS) server and a service transfer point, which reads on claimed "short message service center (SMSC)" and "service control point (SCP)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", including said SMSC, a message handler wherein:

- said registration notification message (REGNOT) and MSINACT (user event information) forwarder replicates, which reads on claimed "copies", all said REGNOT and MSINACT received by said MSC. See paragraphs [0044, 0045, 0046]

Regarding **claims 4, 10, 35 and 41**, as the combination of Mcdowell et al. and Waesterlid are made, the combination according to **claims 1, 7, 32 and 38**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039 and 0047-0048], a short message service (SMS) server and a service transfer point, which reads on claimed "short message service center (SMSC)" and "service control point (SCP)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", including said SMSC, a message handler wherein:

- a gateway, which reads on claimed "wireless internet gateway", to transmit said forwarded notification messages (user event information) over said Internet connection. See FIGURE 1 paragraphs [0033, 0035, 0037, 0039, 0041].

Regarding **claims 5, 11, 36 and 42**, as the combination of Mcdowell et al. and Waesterlid are made, the combination according to **claims 4, 10, 35 and 41**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039 and 0047-0048],

a short message service (SMS) server and a service transfer point, which reads on claimed "short message service center (SMSC)" and "service control point (SCP)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", including said SMSC, a message handler wherein:

- said registration notification message (REGNOT) and MSINACT (user event information) handler communicates with the said gateway, which reads on claimed "wireless internet gateway", using signaling system #7 (SS7) communication protocol. See paragraphs [0033, 0037, 0039, 0041, 0047].

Regarding **claims 6, 12, 37 and 43**, as the combination of Mcdowell et al. and Waesterlid are made, the combination according to **claims 1, 7, 32 and 38**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039 and 0047-0048], a short message service (SMS) server and a service transfer point, which reads on claimed "short message service center (SMSC)" and "service control point (SCP)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", including said SMSC, a message handler wherein:

- said registration notification message (REGNOT) and MSINACT (user event information) is previously forwarded by a said HLR. See FIGURE 10a paragraphs [0029, 0032, 0039].

Regarding **claims 13, 22, 44 and 53**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed "apparatus", for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed "external chat server", of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", comprising:

- receiving an IS-41 conforming registration notification message (REGNOT), as taught by Mcdowell et al when an event trigger is initiated in paragraphs [0046, 0056, 0057, 0058], e.g. when a said user's device is turned on, from a Mobile Switching Center (MSC); and
- automatically forwarding, see FIGURE 10a paragraphs [0032], the said IS-41 conforming registration notification message (REGNOT) over an internet connection, see paragraph [0033], to a said Short Message Service Center (SMSC), which reads on claimed "external chat server". Mcdowell et al teaches of this occurrence in paragraph [0046].

- Additionally, McDowell et al. continues to teach in paragraph [0046], that the transmission of information may be conducted over a variety of communication links, such as TCP/IP.

However, McDowell et al. fails to clearly disclose wherein a wireless chat participant corresponding to said forwarded IS-41 conforming registration notification message being added to a chat room based on said forwarded IS-41 conforming notification message.

Waesterlid discloses in column 6 lines 49-67 and column 7 lines 1-62, wherein messages are communicated directly to other peers in a group. This peer-to-peer communication, as the Examiner has interpreted, is direct parallel to communication performed as users are associated to a chat room.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of McDowell et al (U.S. Publication 2001/0034224 A1) to include Waesterlid (U.S. Patent Number 6,993,325 B1) in order to provide a communication system capable of utilizing peer-to-peer communication for registered members whereby a forwarded registration notification message is transmitted via the network to add said registered members to a respected communication groups (column 7 lines 2-19).

Regarding **claims 14, 23, 45 and 54**, as the combination of McDowell et al. and Waesterlid are made, the combination according to **claims 13, 22, 44 and 53**, McDowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs

[0039, 0046, 0057, 0058], of a method and system, which reads on claimed "apparatus", for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed "external chat server", of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", wherein:

- said registration notification message is a REGNOT message. See paragraph [0046]. Examiner further concludes, as evident in FIGURE 10a, the HLR is receiving the said notification message from the said MSC over a said Internet connection.

Regarding **claims 15, 24, 46 and 55**, as the combination of McDowell et al. and Waesterlid are made, the combination according to **claims 13, 22, 44 and 53**, McDowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed "apparatus", for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed "external chat server", of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", wherein:

- McDowell et al teaches in paragraph [0035], that the said Internet connection utilizes a TCP/IP protocol.

Regarding **claims 16, 25, 47 and 56**, as the combination of Mcdowell et al. and Waesterlid are made, the combination according to **claims 13, 22, 44 and 53**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed "apparatus", for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed "external chat server", of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", wherein:

- Mcdowell et al teaches in paragraphs [0035, 0039, 0040], said registration notification message is additionally forwarded by a said SMSC.

Regarding **claims 20, 29, 51 and 60**, as the combination of Mcdowell et al. and Waesterlid are made, the combination according to **claims 13, 22, 44 and 53**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed "apparatus", for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed "external chat server", of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", wherein:

- said registration notification message is signaling system #7 (SS7) and IS-41 compliant. See paragraph [0046, 0054].

Regarding **claims 21, 30, 52 and 61**, as the combination of Mcdowell et al. and Waesterlid are made, the combination according to **claims 13, 22, and 44**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed "apparatus", for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed "external chat server", of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", wherein:

- said registration notification message is IS-41 compliant. See paragraph [0046, 0054].

Regarding **claims 31 and 62**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method for automatically notifying an external message distribution system, commonly referred to as a Mobile Event Server (MES), which reads on claimed "external chat server", of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", comprising:

- receiving an IS-41 conforming MSINACT, which reads on claimed "MSInactivity notification", as taught by McDowell et al when an event trigger is initiated in paragraphs [0046, 0056, 0057, 0058], e.g. when a said user's device is turned on, from a Mobile Switching Center (MSC); and
- automatically forwarding, see FIGURE 10a paragraphs [0032], the said IS-41 conforming MSINACT, which reads on claimed "MSInactivity notification", over an internet connection, see paragraph [0033], to a said Mobile Event Server (MES), which reads on claimed "external chat server". McDowell et al teaches of this occurrence in paragraph [0046].
- Additionally, McDowell et al. continues to teach in paragraph [0046], that the transmission of information may be conducted over a variety of communication links, such as TCP/IP.

However, McDowell et al. fails to clearly disclose wherein a wireless chat participant corresponding to said forwarded registration notification message being added to a chat room based on said forwarded registration notification message.

Waesterlid discloses in column 6 lines 49-67 and column 7 lines 1-62, wherein messages are communicated directly to other peers in a group. This peer-to-peer communication, as the Examiner has interpreted, is direct parallel to communication performed as users are associated to a chat room.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of McDowell et al (U.S. Publication 2001/0034224 A1) to include Waesterlid (U.S. Patent Number 6,993,325 B1) in order to

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provide a communication system capable of utilizing peer-to-peer communication for registered members whereby a forwarded registration notification message is transmitted via the network to add said registered members to a respected communication groups (column 7 lines 2-19).

2. **Claims 17-19, 26-28, 48-50 and 57-59** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mcdowell et al (U.S. Publication 2001/0034224 A1) in view of Waesterlid (U.S. Patent Number 6,993,325 B1) in further view of Sandegren (U.S. Patent 6,512,930 B2).

Regarding **claims 17, 26, 48 and 57**, as the combination of Mcdowell et al. and Waesterlid are made, the combination according to **claims 13, 22, 44 and 53**, the combination fails to disclose of adding a user corresponding to the forwarded registration notification message to a chat session.

Sandegren (U.S. Patent 6,512,930 B2) teaches in column 5 and 6 lines 46-67 lines 1-17 respectively, of automatically adding a user of a mobile station corresponding to a said forwarded notification that the said user is "on-line", which in turn, adds the user to a list of individuals whose status of communication is of relevance to the said user (see column 3 lines 1-10), which reads on claim "chat session".

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the combination of combination of Mcdowell et al. and Waesterlid to include Sandegren (U.S. Patent 6,512,930 B2) in order to achieve a method and apparatus where a user corresponding to a forwarded notification message can be automatically added to a chat session.

Regarding **claims 18, 27, 49 and 58**, as the combination of Mcdowell et al. and Waesterlid are made, the combination according to **claims 17, 26, 48 and 57**, the

combination fails to disclose of automatically notifying other chat participants of the presence of the added user.

Sandegren (U.S. Patent 6,512,930 B2) teaches in column 5 and 6 lines 46-67 lines 1-17 respectively, of automatically adding a user of a mobile station corresponding to a said forwarded notification that the said user is "on-line", which in turn, adds the user to a list of individuals whose status of communication is of relevance to the said user (see column 3 lines 1-10), which reads on claim "chat session". Additionally, as stated in column 3 lines 56-66, that an action is preformed in order to notify other chat participants, which reads on claimed "chat participants", who are of the same status as the added user that the user is available for communication.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the combination of combination of Mcdowell et al. and Waesterlid to include Sandegren (U.S. Patent 6,512,930 B2) in order to achieve a method and apparatus which automatically notifies other chat participants regarding the presence of a an automatically added said user.

Regarding **claims 19, 28, 50 and 59**, as the combination of Mcdowell et al. and Waesterlid are made, the combination according to **claims 17, 26, 48 and 57**, the combination fails to disclose of an external server automatically sending a list of chat participants to the added user.

Sandegren (U.S. Patent 6,512,930 B2) teaches in column 5 and 6 lines 46-67 lines 1-17 respectively, that the server or Wireless On-line Notification (WOLN) server sends

a list of "on-line" users, which reads on claimed "chat participants", to a said user of interest.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to the combination of combination of McDowell et al. and Waesterlid to include Sandegren (U.S. Patent 6,512,930 B2) in order to achieve a method and apparatus which automatically sends a list of chat participant to a user of interest to established communications with the list chat participants if the user so desires.

Response to Arguments

Applicant's arguments with respect to **claims 1-62** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randy Peaches
RP


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER